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UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

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2008-1151  
(Serial No. 09/326,405)

IN RE DAVE B. LUNDAHL

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Appeal from the United States Patent and Trademark Office,  
Board of Patent Appeals and Interferences.

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APPELLANT'S REPLY BRIEF

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## Argument

In response to the Reply Brief for Appellee, Director of the U.S. Patent and Trademark Office, new issues were raised by Appellee in the Brief. Primarily, Appellee has argued that a “strong” *prima facie* case of obviousness was presented by the USPTO and that, since a “strong” *prima facie* case was presented, the evidence of commercial success is outweighed by the *prima facie* case. In fact, that was not the case during the prosecution of the application in the USPTO. Appellant had attempted to simplify the issues for appeal by focusing on the USPTO’s refusal to consider the commercial success shown by the Applicant for the reason, as stated by the Board, that neither the Helzer Declaration nor the Thompson Declaration demonstrated the requisite nexus between the asserted commercial success of window systems within the scope of the appealed claims (A18-19; A1-3). See also, Brief for Appellee, p. 9. However, this new issue requires a response, because a strong *prima facie* case was not presented by the USPTO.

### **1. THE KEHNE REFERENCE COMPRISES A TEACHING AWAY FROM THE USE OF A REMOVABLE SCREEN.**

The Examiner rejected Appellant’s claims as being unpatentable over Kehne (2,713,896) in view of Lazarek (3,753,458). Kehne discloses a screen 28 that is mounted in a rigid frame 27, which, in turn, is mounted

against the jams 26 of a window. Kehne states, in column 1, lines 60-62 (A262), that the window system contains a “provision of means for supporting a screen substantially within the confines of the fixed frame member in a more or less permanent manner.” (Emphasis added.)

Kehne clearly teaches away from a removable screen, as set forth in Appellant’s claims, by stating that the screen is attached in a “more or less permanent manner” in a “fixed frame member.” Webster’s New World Dictionary, Second College Edition, defines “more or less” as “approximately.” There is no other teaching in Kehne with regard to the “more or less permanent” disposition of the Kehne screen. The Patent Office has argued that “more or less permanent” can also mean “temporary mounting manner.” The USPTO cites no support for such an interpretation. Appellant, on the other hand, has cited Webster’s Dictionary, which defines “more or less” as “approximate.” The window screen that is “approximately permanent” does not mean that it is temporarily mounted, as argued by the Examiner. The Examiner’s arguments turn the description of the Kehne reference on its head, in an attempt to ascribe a contrary meaning to the term “more or less permanent.” Appellant believes that Kehne intended that the screen be removed for servicing, but otherwise affixed to the frame. Although there is no discussion of the manner in which the frame is held in place in Kehne, screens installed on exterior frames of

casement windows are not readily removed or installed from the inside. Therefore, Appellant respectfully believes that the screen of Kehne is intended to remain in place.

A reference that teaches away from an invention may not properly be used in framing a 35 USC § 103 rejection of claims to that invention. See, United States v. Adams, 148 USPQ 429 (S.Ct. 1966). It is therefore improper to combine Kehne with another reference to show a removable screen because Kehne teaches away from the concept of a removable screen. All of Appellant's independent claims specifically claim a "removable screen."

## **2. LAZAREK TEACHES AWAY FROM THE USE OF A PERMANENT SCREEN.**

Lazarek, on the other hand, specifically teaches away from the use of a permanent screen, such as that disclosed in Kehne. Lazarek, at column 1, lines 20-27, states:

"permanently attached screens to the automobile windows are undesirable, in that they impair visibility and are probably not necessary, in view of the fact that insect annoyance is a serious problem only when the automobile is parked, because when the vehicle is moving, the rush of air past the vehicle is sufficient to prevent insects from entering a moving automobile."

Hence, Lazarek teaches the use of a removable screen and states that permanently attached screens are undesirable. Hence, Lazarek teaches away

from the teachings of a more or less permanent screen, as disclosed by Kehne.

**3. THE COMBINATION OF KEHNE AND LAZAREK WOULD REQUIRE A CHANGE IN THE PRINCIPLES OF OPERATION OF THE REFERENCES.**

The teachings of these references with respect to permanent or removable screens are inconsistent, and the combination of these references would necessarily require a change in the principles of operation of the references. See, In re Gordon, 221 USPQ 1125, 733 F.2d 900 (Fed. Cir. 1984). Because the principles of operation taught by Kehne and Lazarek are substantially different, the problems and solutions of mounting the screens are substantially different.

As pointed out above, Lazarek teaches a process of mounting of a window screen on the interior portion of the frame of a car window which can be easily installed or removed from the interior of the car, while Kehne teaches permanently mounting a fixed screen having a rigid frame on the exterior portion of the window between the fixed frame and a moving sash, which may not be easily accessible.

In other words, Kehne teaches that the screen must be held in a fixed frame and more or less permanently attached to the outer portion of the frame, while Lazarek teaches the use of a removable screen that attaches to the interior portion of the window for easy access and has a non-rigid frame.

If the window screen of Lazarek were to be applied to a casement window in the manner that Lazarek requires, i.e., mounting the screen to the interior portion of the window frame to make it accessible, the crank and latching mechanisms of a casement window would interfere with the screen. Such a combination would result in an inoperable system. To attach the screen to the exterior portion of the window, as taught by Kehne, would make the screen less accessible and harder to mount, which is contrary to the teachings of Lazarek. Of course, inaccessibility and difficulty in mounting a fixed screen are not issues that are of importance to Kehne, since Kehne has a permanent screen in a “fixed frame.” In either case, a change in the principles of operation of the references would be required to make the suggested combination.

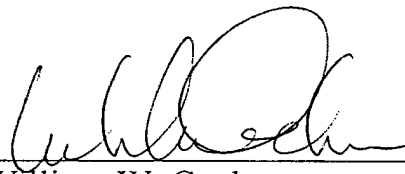
The USPTO’s response to Appellant’s position that the principles of operation of Kehne and Lazarek would be changed by the suggested combination of these references is not well founded. It is clear that the principles of operation of Kehne and Lazarek are different. Kehne requires a rigid screen frame 27 to hold the screen 28 in the window frame 11. Lazarek requires no frame and will not work with a rigid frame.



## Conclusion

For these reasons, a *prima facie* case of obviousness was not established by the Patent Office, let alone a “strong” *prima facie* case, that Appellee argues outweighs Appellant’s showing of commercial success under Graham v. John Deere Co., 383 U.S. 1 (1966), and KSR International Co. v. Teleflex, 550 U.S. \_\_\_\_\_, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

Dated: May 2, 2008

  
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William W. Cochran

**Proof of Service**

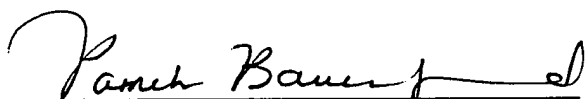
United States Court of Appeals for the Federal Circuit

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The undersigned hereby certifies that two copies of the attached  
APPELLANT'S REPLY BRIEF were sent today via Express Mail to:

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A handwritten signature in cursive script, reading "Patrick Bauer", followed by a horizontal line.

Date: May 2, 2008

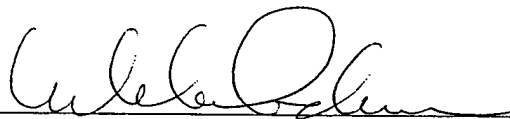
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**Certificate of Compliance (Federal Rule 32)**

The undersigned hereby certifies that this brief has fewer than 7,000 words (in fact, 1,284 words), as counted by the word processing software.

Dated: May 2, 2008

  
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